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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,592	12/28/2001	Michael J. Lego	010575	8737
26285	7590	04/29/2009	EXAMINER	
K&L GATES LLP			WEIS, SAMUEL	
535 SMITHFIELD STREET				
PITTSBURGH, PA 15222			ART UNIT	PAPER NUMBER
			3695	
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			04/29/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/033,592	LEGO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SETH WEIS	3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 December 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-34 is/are pending in the application.  
 4a) Of the above claim(s) 5,14,16,21,22,24,26,28 and 29 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4,6-13,15,17-20,23,25,27 and 30-34 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

### **DETAILED ACTION**

1. This is in response to the Applicants' Request for Continued Exam (RCE) filed on December 24, 2008. Claims 1-34 are currently pending. Claims 1, 8, and 15 have been amended. Claims 5, 14, 16, 21, 22, 24, 26, 28, and 28 were cancelled. Claims 1-4, 6-13, 15, 17-20, 23, 25, 27 and 30-34 have been examined.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 24, 2008 has been entered.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-4, 6-13, 15, 17, 18, and 31-34 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

Claims 1-4, 6-13, 15, 17, 18, and 31-34 recite processes comprising the steps of receiving, associating, analyzing, identifying, generating, notifying, and transmitting. Based on Supreme Court precedent, a proper process must be tied to another statutory

class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claims 23, 25, 27, and 30 recite in the preamble “a computer-readable medium containing instructions for assisting a computer system to perform a method for processing financial information of a client of a financial institution, said method comprising.” Claim 23 is considered non-statutory because the steps are considered to be software, *per se*. Functional descriptive material *per se* is not statutory. Functional descriptive material in combination with an appropriate computer readable medium must be capable of producing a useful, concrete and tangible result when used in a computer system. Since the “steps” lack storage on a medium and there are no instructions in executable form, no underlying functionality occurs and thus there is no practical application. For these reasons, claims 23 fails to satisfy one of the statutory categories set forth in 35 U.S.C. 101 and is therefore considered to be non-statutory. Claims 25, 27, and 30 are dependent from claim 23 and stand rejected under the same reasoning.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-13, 15, 17-20, 23, 25, 27 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al., U.S. Pat. No. 5,649,116 (hereinafter, McCoy), in view of Simmons et al., U.S. Pat. No. 5,093,787 (hereinafter, Simmons).

As to claims 1 and 23, McCoy discloses computer-assisted method and medium for processing financial information of a client of a financial institution, comprising: receiving data from an overdraft data source, said data including at least one overdraft occurrence associated with a transaction performed in association with said client (i.e. In order to monitor a plurality of associated accounts, the computer has access to the various account files containing information on the accounts; A warning limit indicates that the relationship requires attention, but that the transaction may be allowed) (col. 6, lines 39-41; col. 7, lines 12-14);

associating said overdraft occurrence with an Overdraft representative, wherein said overdraft representative is responsible for at least one of reviewing, researching and documenting the circumstances of said overdraft occurrence (i.e. the system performs a warning limit test to determine whether the transaction would cause the total exposure of the relationship to exceed the predetermined warning limit for the relationship, as

listed in the relationship profile; system performs a hold routine, notify routine, or alert limit test) (col. 7, lines 63-67; col. 8, lines 1-12);

analyzing said overdraft occurrence in an overdraft application to determine at least one circumstance surrounding a cause of said overdraft occurrence and a disposition for said overdraft occurrence in connection with said cause (i.e. monitoring means for determining a combined exposure) (claim 1);

identifying at least one approval authority for said overdraft occurrence (i.e. CIF system provides information as to how different accounts are related to each other) (col. 6, lines 50-51);

generating an overdraft report, wherein said overdraft report contains observations of said analyzing step (i.e. the system performs an alert routine to alert the primary relationship officer) (col. 8, lines 21-22);

notifying at least one of a manager or the approval authority of the need to approve disposition of the overdraft occurrence (i.e. any means of enabling a computer to alert an officer) (col. 6, lines 32-33); and

transmitting a response by one of the manager or the approval authority to said overdraft report to said overdraft application (i.e. system performs a notification to notify the application requesting the transaction) (col. 8, lines 61-67).

McCoy does not explicitly disclose electronic mail. However, Simmons teaches an electronic checkbook with automatic reconciliation including creating overdraft prevention reports which can be sent via electronic mail (col. 7, lines 29-46). It would have been obvious to one skilled in the art at the time of Applicant's invention to

combine McCoy and Simmons because the features of each are old and well known in the art.

As to claims 2-4, 6, and 7, McCoy discloses wherein said financial institution includes a banking institution (i.e. the present invention 10 comprises a bank's computer interconnected with several banking transaction enabling devices) (col. 6, lines 12-14); said analyzing step includes analyzing said overdraft occurrence with an overdraft representative (i.e. if the total exposure would not exceed the alert limit, the system performs a warn routine notifying the primary relationship officer) (col. 8, lines 13-16); receiving said overdraft occurrence into a pending overdraft portion of said overdraft application (i.e. If the primary officer responds in a timely fashion, then the system will execute a wait sequence while the primary officer reviews the transaction, the relationship and any other significant factors) (col. 8, line 44-49); accessing a lending authority database of said overdraft application for identifying said approval authority (i.e. if the primary officer's authorization limit has not been exceeded, the system waits for a timely response 306 from the primary officer) (col. 8, lines 33-35); wherein said generating step further comprises documenting one or more reasons for said overdraft occurrence in said overdraft report (i.e. alert limit exceeded routine begins by performing an operations notification routine to notify the primary officer and the bank's operation area responsible for the payment system originating the transaction that the relationship's alert limit has been exceeded) (col. 8, 25-28).

As to claims 8-13, 15, 17, and 18 McCoy discloses wherein said generating step further comprises entering a disposition code into said overdraft report (i.e. system

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performs a notification to notify the application requesting the transaction) (col. 8, lines 61-67); wherein said disposition code includes a recommendation that an action to be taken in response to said overdraft occurrence which includes paying an item associated with said overdraft occurrence without charging a fee to said client (i.e. Hold routine then performs a customer profile access 504 to determine the pricing schedule to be used to determine DOD charges) (col. 9, lines 57-59); wherein said disposition code includes a recommendation that an action to be taken in response to said overdraft occurrence which includes paying an item associated with said overdraft occurrence and charging a fee to said client (i.e. Hold routine then performs a customer profile access 504 to determine the pricing schedule to be used to determine DOD charges) (col. 9, lines 57-59); wherein said disposition code includes a recommendation that an action to be taken in response to said overdraft occurrence which includes returning an item associated with said overdraft occurrence without charging a fee to said client (i.e. If the officer instructs the system not to stage the transaction, a routine to handle denied transactions is performed and a notify application routine is performed) (col. 9, lines 25-29); wherein said disposition code includes a recommendation that an action to be taken in response to said overdraft occurrence which includes returning an item associated with said overdraft occurrence and charging a fee to said client (i.e. If the officer decides not to authorize the transaction, the system executes a transaction denied routine) (col. 9, lines 44-46); identifying at least one approval authority alternate for addressing said overdraft occurrence (i.e. Backup officer) (col. 8, line37); performing an auto-check of an approval authority amount associated with said overdraft

occurrence prior to notifying said manager (i.e. the system next performs an alert limit test to determine whether the transaction would cause the total exposure of the relationship to exceed the predetermined alert limit) (col. 8, lines 11-13); communicating said manager response to said overdraft data source for disposition of said overdraft occurrence (i.e. system waits for a timely response from the primary officer) (col. 8, lines 35-37); wherein if no response to said overdraft report is provided by said manager, communicating a default response to said overdraft data source for disposition of said overdraft occurrence (i.e. If a timely response is not received from the primary officer, the system performs a notification routine to notify the operations area and a backup officer) (col. 8, lines 35-39).

As to claims 19 and 20, McCoy discloses a system for processing financial information of a client of a financial institution, said system comprising:

an overdraft application for receiving data from an overdraft data source, said data including at least one overdraft occurrence associated with a transaction performed in association with said client, said overdraft application configured for analyzing said overdraft occurrence to determine at least one circumstance surrounding a cause of said overdraft occurrence and a disposition for said overdraft occurrence in connection with said cause(i.e. In order to monitor a plurality of associated accounts, the computer has access to the various account files containing information on the accounts; A warning limit indicates that the relationship requires attention, but that the transaction may be allowed) (col. 6, lines 39-41; col. 7, lines 12-14); (i.e. the system performs a warning limit test to determine whether the transaction would cause the total

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exposure of the relationship to exceed the predetermined warning limit for the relationship, as listed in the relationship profile; system performs a hold routine, notify routine, or alert limit test) (col. 7, lines 63-67; col. 8, lines 1-12); (i.e. the system performs an alert routine to alert the primary relationship officer) (col. 8, lines 21-22); a server connection for communicating an overdraft report associated with said analysis of said overdraft occurrence, wherein said overdraft report contains observations of said overdraft application (i.e. in order to alert the appropriate officers at the bank of important account-related events (such as a predetermined limit being exceeded), the computer is connected to alerting means, ... any means of enabling a computer to alert an officer could be used) (col. 6, lines 27-33); and at least one lending authority database operatively associated with said overdraft application for identifying at least one approval authority for said overdraft occurrence (i.e. CIF system provides information as to how different accounts are related to each other) (col. 6, lines 50-51); at least one database operatively associated with said overdraft application for receiving at least one pending overdraft occurrence (i.e. computer interfaces with the bank's existing customer information file system) (col. 6, lines 47-49).

McCoy does not explicitly disclose a mail server configured for: communicating a notification to at least one of a manager or the approval authority of the need to approve disposition of the overdraft occurrence mail; and receiving a response for said overdraft application from one of the manager or the approval authority. McCoy discloses identifying at least one approval authority for said

overdraft occurrence (i.e. primary officer limit exceeded test) (col. 8, line 30). However, Simmons teaches an electronic checkbook with automatic reconciliation including creating overdraft prevention reports which can be sent via electronic mail (col. 7, lines 29-46). It would have been obvious to one skilled in the art at the time of Applicant's invention to combine McCoy and Simmons because the features of each are old and well known in the art.

As to claims 25, 27, and 30, McCoy discloses at least one lending authority database operatively associated with said overdraft application for identifying at least one approval authority for said overdraft occurrence (i.e. CIF system provides information as to how different accounts are related to each other) (col. 6, lines 50-51); performing an auto-check of an approval authority amount associated with said overdraft occurrence prior to notifying said manager (i.e. the system next performs an alert limit test to determine whether the transaction would cause the total exposure of the relationship to exceed the predetermined alert limit) (col. 8, lines 11-13); wherein if no response to said overdraft report is provided by said manager, communicating a default response to said overdraft data source for disposition of said overdraft occurrence (i.e. If a timely response is not received from the primary officer, the system performs a notification routine to notify the operations area and a backup officer) (col. 8, lines 35-39).

As to claims 31-34, these independent claims are rejected as being various combinations of independent claim 1 and its dependent claims as rejected and discussed above.

***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SETH WEIS whose telephone number is (571)272-1882. The examiner can normally be reached on 8:30 to 5, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SETH WEIS/  
Examiner, Art Unit 3695

/Narayanswamy Subramanian/  
Primary Examiner, Art Unit 3695